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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,493	09/15/2003	Yuuichirou Tsuruta	0505-1245P	9236
2292 7590 11/09/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER EDWARDS, LOREN C	
			ART UNIT 3748	PAPER NUMBER
			NOTIFICATION DATE 11/09/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/661,493

Applicant(s)

TSURUTA, YUUICHIROU

Examiner

Loren C. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3-10 and 21-23 is/are allowed.
- 6) ☒ Claim(s) 11, 13-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 12, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. An Applicant's Amendment filed on 10/19/07 has been entered. Claim 2 has been canceled; claims 1, 8, 11, 12, 18, and 21 have been amended; and claims 22 and 23 have been added. Overall, claims 1, and 3-23 are pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

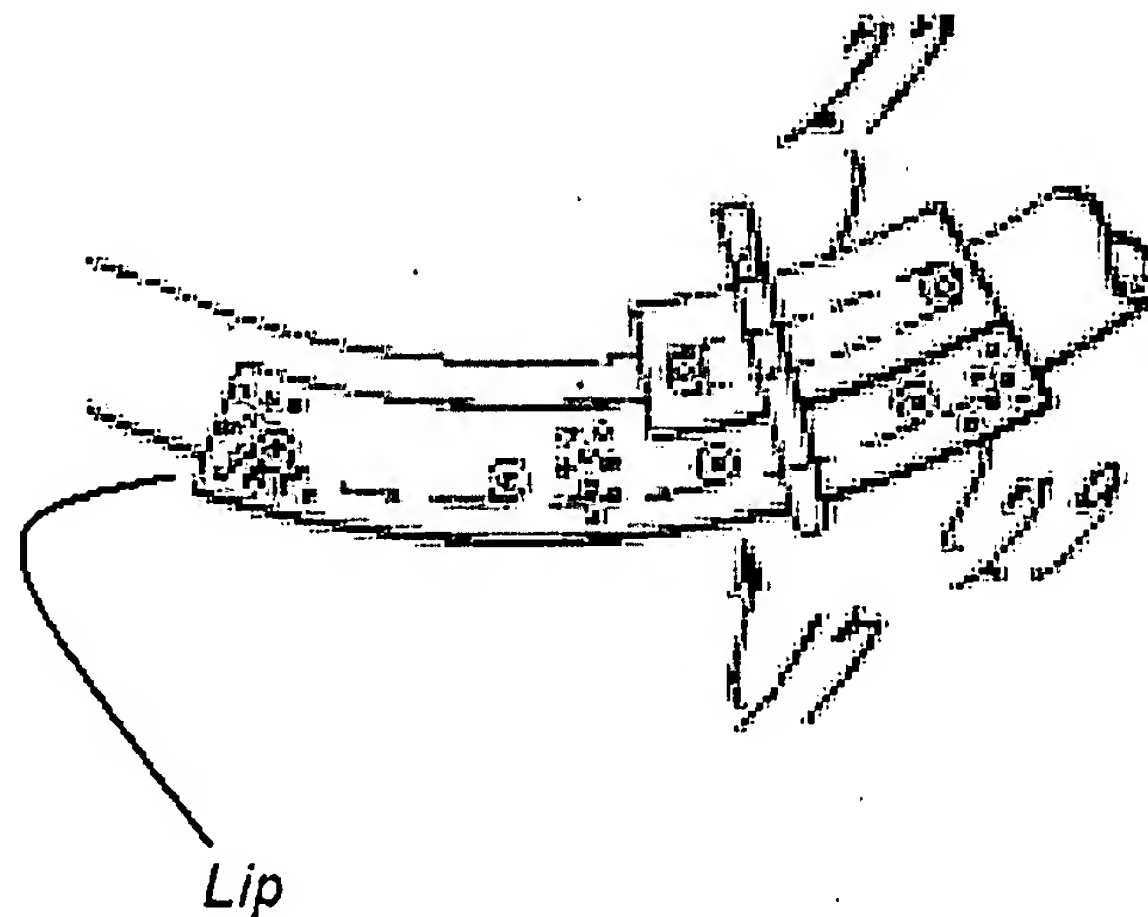
A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 15-17, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heath (U.S. 3,863,445). Heath discloses a heat shield for an exhaust system member extending from an exhaust port of an internal combustion engine, comprising: a first heat shield plate (Fig. 1, No. 29) for surrounding substantially all of a curved section of the exhaust system member, the curved section of the exhaust system member extending from the exhaust port; a second heat shield plate (Fig. 1, No. 21) mounted over a straight section of the exhaust system member, the straight section connecting to the curved section (Fig. 1, No. 11); and a band member (Col. 2, Lines 52-63) for supporting the first heat shield plate on the exhaust system member, wherein the first heat shield plate is formed as a single plate extending along at least half way along the curved section of the exhaust system member (Fig. 1, No. 29), wherein a rear end section of the first heat shield plate is in direct contact with the exhaust member (Col. 2, Lines 41-49) and a front end section of the second heat shield plate is separated from

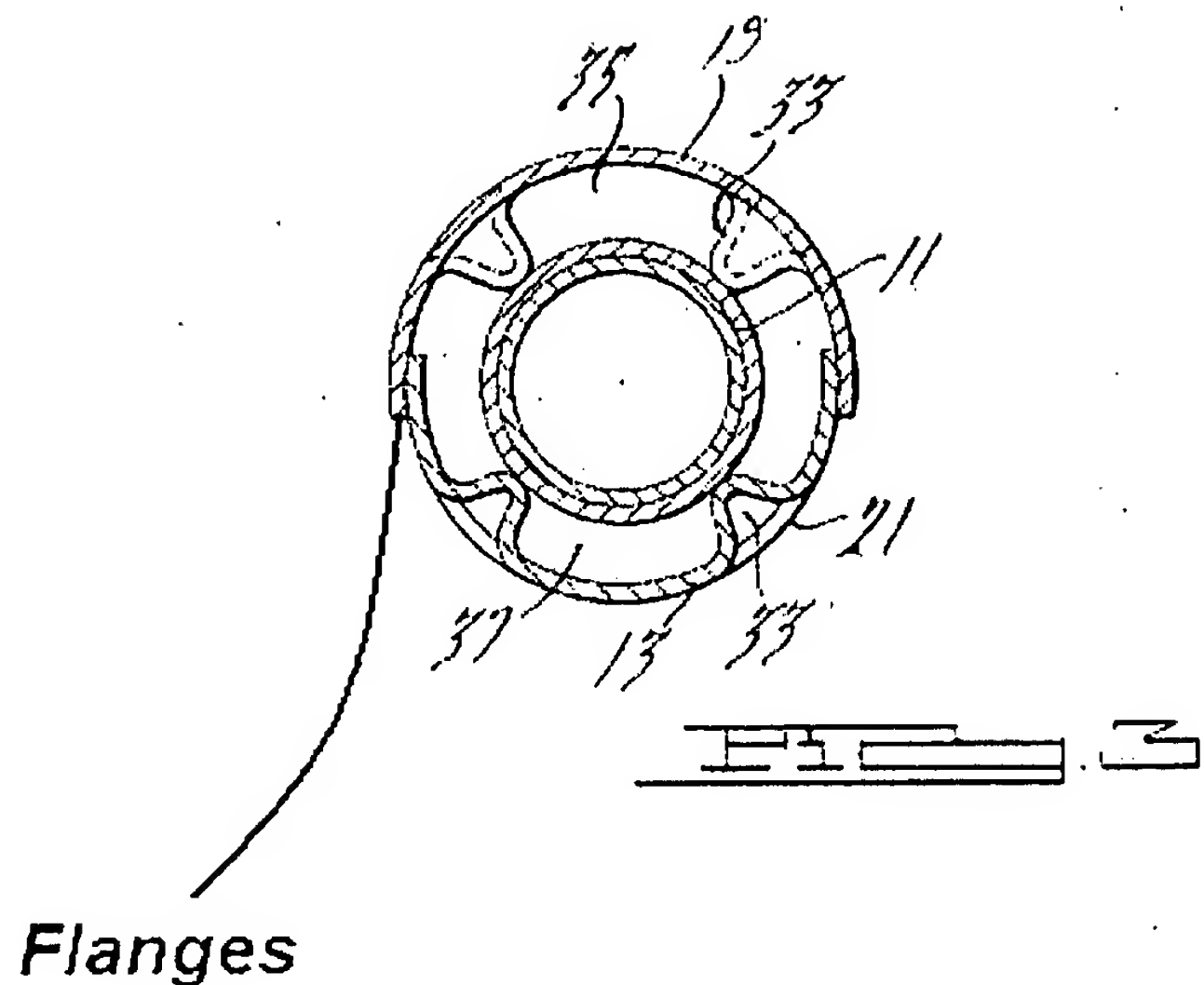
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the exhaust system (Col. 2, Lines 49-52), thereby forming a gap between the rear end section of the first heat shield plate and the front end section of the second heat shield plate (Fig. 1, Space between 21 and 29), wherein the gap provides an opening facing toward a front side of the vehicle (Modified Fig. 1 - Lip) so that travel wind from the front side of the vehicle passes through a gap between the first and second heat shield plates.



Modified Fig. 1 – Added reference notations

4. With regards to claim 15, Heath discloses the heat shield of claim 11, as described above, and further wherein the first heat shield includes an upper plate (Fig. 1, No. 27) and a lower plate (Fig. 1, No. 29) each having flanges (Modified Fig. 3, Flanges) on inner and outer edges thereof, the flanges of the upper plate mating with the flanges of the lower plate, so that the upper plate and the lower plate surround the exhaust system member (Fig. 1, Nos. 27 and 29).



Modified Fig. 3 – Added reference notations

5. With regards to claim 16, Heath discloses the heat shield of claim 15, as described above, and further wherein the upper plate and the lower plate are joined by the band member and surround an entire circumference of the curved section of the exhaust system member (Fig. 1, Nos. 27 and 29).
6. With regards to claim 17, Heath discloses the heat shield of claim 11, as described above, and further wherein an end of the first heat shield plate adjacent to the exhaust port of the engine includes projection sections (Fig. 3, No. 33; Col. 2, Lines 41-49), and the band member presses the projection sections against the exhaust system member to attach the first heat shield plate to the exhaust system member (Fig. 3).
7. With regards to claim 20, Heath discloses the heat shield of claim 11, as described above, and further wherein an intermediate portion of the first heat shield plate has a diameter larger than a diameter of the exhaust system member, and the

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band member wraps around the intermediate portion of the first heat shield plate (Col. 2, Lines 52-63).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Heath in view of design choice. Heath discloses the heat shield of claim 11, as described above, but fails to describe a U-shaped exhaust pipe leaving the engine. The geometry of the exhaust system is recognized as a results effective variable wherein the routing of the exhaust is based on the specifics of the vehicle (e.g. engine location, muffler location, etc.). It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the geometry of the exhaust system in any manner, including that claimed, based on the specifics of the vehicle in which it is being installed. It has been held that where the general conditions of a claim are disclosed in

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the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Allowable Subject Matter

11. Claims 1, 3-10, and 21-23 allowed.

12. Claims 12, 18, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

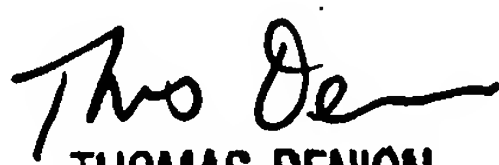
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Loren C. Edwards whose telephone number is (571) 272-2756. The examiner can normally be reached on M-TH 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Loren Edwards
(571) 272-2756




THOMAS DENION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700